RJL

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES and PAUL REUBEN DAY

Appeal No. 2004-0224
Application No. 09/292,444

ON BRIEF

Before KRASS, BARRETT and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-10, 12-14, 16 and 17.

The invention is directed to identifying hypertext links in document printouts. A document to be printed is scanned for identifying local hypertext links within the document. A page location of each identified local hypertext link within the document is computed and stored. Printable objects are

sequentially checked to identify each printable object within a hypertext anchor tag. Each identified printable object within a hypertext anchor tag is rendered with a predefined indication of the hypertext link.

Representative independent claim 1 is reproduced as follows:

1. A computer implemented method for identifying hypertext links in document printouts comprising the steps of:

scanning a document to be printed and identifying local hypertext links within the document,

computing and storing a page location of each identified local hypertext link within the document,

sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

The examiner relies on the following references:

Stork et al. (Stork)	5,781,914	Jul. 14, 1998
Kogan et al. (Kogan)	5,809,317	Sep. 15, 1998

"Microsoft Word Tutorial, 'Microsoft Word Basic Features'", http://baycongroup.com/wlesson0.htm, pp. 1-3 and 1-8, Microsoft Word 1997. (Microsoft)

Advanced Microsoft Word, "Footnotes and Endnotes" http://www.utexas.edu/cc/training/handouts/wordadv/ Jan. 24, 2001, Copyright 1996, Computation Center, The University of Texas at Austin. (Advanced Microsoft)

Claims 1-10, 12-14, 16 and 17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Stork and Kogan with regard to claims 1-3, 6, 10, 12-14, 16 and 17, adding, alternatively, Microsoft with regard to claims 4, 5 and 8, and Advanced Microsoft with regard to claims 7 and 9.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

With regard to independent claim 1, the examiner points to column 1, lines 5-10, of Stork for a "computer-implemented method for identifying hypertext links in document printouts;" to column 9, lines 9-10, of Stork for "scanning a document to be printed and identifying local hypertext links within the document;" to column 5, lines 1-30, of Stork for "computing and storing a page location of each identified local hypertext link within the

document;" and to column 5, lines 25-30, of Stork for the "rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link."

The examiner indicates that Stork does not disclose any step of "checking printable objects to identify each printable object within a hypertext anchor tag" but turns to Kogan. The examiner cites the abstract of Kogan for a teaching of creating and maintaining hypertext links among documents through the use of anchors; and column 5, lines 20-30, along with Figures 6-8, of Kogan, for a teaching of using database management technology to relate anchors to links and links to anchors.

The examiner concludes that it would have been obvious "to combine Stork's method of identifying hypertext links in the hypertext document for conversion into a hardcopy document (capable of being printout) with Kogan's method of checking objects for hypertext anchor tags with a related link since it enables the identification of hypertext links within a document as well as its location" (answer-page 4).

For their part, appellants argue that neither Stork nor Kogan nor any combination thereof provides for the claimed

"checking printable objects to identify each printable object within a hypertext anchor tag" and "rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link." Appellants contend that the machine readable encoded information provided by Stork "is not equivalent to nor does not achieve, nor suggest the step of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link" (principal brief-page 15).

We note that appellants do not present compelling arguments for patentability since they merely recite certain claim limitations, e.g., "checking printable objects..." and "rendering each identified printable object within said hypertext anchor tag..." and state that the references do not disclose or suggest these limitations, without ever specifically addressing the examiner's reliance on particular portions of the reference and stating why appellants believe that these portions do not teach what the examiner purports them to teach, i.e., appellants never convincingly point out why the examiner's position is in error.

For example, appellants argue that the machine readable encoded information in Stork is not equivalent to the claimed step of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link, but appellants never point out why they believe this to be the case.

Nevertheless, we will not sustain the rejection of claims 1-10, 12-14, 16 and 17 under 35 U.S.C. § 103 because it is the examiner's burden, in the first instance, to establish a prima facie case of obviousness with regard to the instant claimed subject matter, and it is our view that the examiner has not done so.

Stork is directed to converting hardcopy documents to hyperdocuments, permitting the construction of a hyperdocument complete with links from a hardcopy version of the document, and vice-versa. The examiner contends that Stork may be construed to teach the claimed scanning of a document and computing and storing page location of identified local hypertext links within the document. The examiner also contends that Stork does not disclose the claimed "checking printable objects to identify each printable object within a hypertext anchor tag," turning to Kogan

for a teaching of such an "anchor tag." We agree that Kogan discloses anchor tags, or "anchors," defined as endpoints of hyperlinks.

In reviewing the disclosed "anchors" of Kogan, however, there is no discussion therein regarding "checking printable objects to identify each printable object within a hypertext anchor tag." Moreover, even assuming, arguendo, that Kogan could be interpreted, in some way, as disclosing such an "anchor tag," the instant claimed invention requires more from such an "anchor tag." That is, there must be a rendering of each identified printable object "within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link." Yet, the examiner never fully explains how the applied references are to be specifically applied to the instant claimed subject matter.

The examiner does not even rely on Kogan for this "rendering" step, indicating, instead, column 5, lines 25-30, of Stork for this teaching, interpreting Stork's encoding of path information with a link as evidence of the obviousness of displaying path information (interpreted by the examiner as an URL) while rendering the printable objects for any type of link.

The examiner's findings do not reasonably lead to a conclusion of obviousness. The instant claims call for a "local" hypertext link and an "external" hypertext link.[1] These terms are reasonably defined in the instant disclosure, with a "local" hypertext referring to a section of a current document that is within the same URL, and an "external" hypertext link referring to hypertext in another URL. The invention, as reasonably defined by the instant claims, checks the document that is to be printed. If there are no links, the document is processed as normal. If there is a "local" link, the document is printed with a page location indicated for each such local hypertext link. If there is an "external" link, the document is printed with the URL of the external link. The examiner has not pointed out how these local and external links, and the relation therebetween, are to be found in the applied references.

The examiner indicates that Kogan teaches a need to establish and maintain associations between documents as a means to link objects at a region in the document, with "anchors" allowing these relationships to be established. That may be, but

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[1]Independent claim 13 mentions an "external" hypertext link, but not, specifically, a "local" hypertext link, while independent claim 17 mentions a "local" hypertext link but not, specifically, an "external" hypertext link.

this still does not establish the claimed "checking printable objects to identify each printable object within a hypertext anchor tag" and the examiner has not set forth any convincing reason as to why Kogan's "anchors" are to be considered suggesting the step of "checking printable objects to identify each printable object within a hypertext anchor tag."

Moreover, it just does not follow, from the examiner's assertion of Kogan's "anchors" and Stork's printing of location and hyperlink information, that the artisan would have taken such teachings and have been led to check printable objects to identify each printable object within a hypertext anchor tag, and then render each identified printable object within the hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding URL for each external hypertext link. We do not even see any teaching, or suggestion, of "local" and "external" hypertext links, as defined by the instant disclosure, within the applied references, and it is unclear, from the examiner's explanation, just what, in the references, the examiner is equating to these claimed limitations.

Now, it may be that the applied references might contain teachings that would render the instant claims, or some of them,

obvious, within the meaning of 35 U.S.C. § 103. Clearly, without using the terms "local" and "external," there may be teachings applicable to these claimed features. For example, in Figure 1, and column 4, lines 38 et seq., of Stork, it is disclosed that encoded information contains hyperlink information used in a document to actively retrieve other portions of the document ("local"?) or other documents ("external"?).

Moreover, without employing the term, "anchor tag," it may very well be that Stork discloses such "anchor tags" because an anchor is no more than a description of the endpoints of hyperlinks, and Stork must somehow describe these endpoints in order to describe the hyperlinks.

However, the examiner does not specifically address these issues and has not given us enough information to determine that the examiner has reasonably set forth a prima facie case of obviousness with regard to the instant claimed subject matter. Thus, while the instant claims appear rather broad in scope, and appellants' arguments are insufficient to overcome any prima facie case established by the examiner, the examiner has not produced sufficient evidence of obviousness, based on the examiner's explanation of the references, to enable us to find for the examiner.

Independent claims 10, 13 and 17 include limitations similar to those in independent claim 1 and we will not sustain the rejection of these claims for the same reasons we will not sustain the rejection of independent claim 1 under 35 U.S.C. § 103.

We note that the Microsoft and Advanced Microsoft references add nothing which would provide for the deficiencies of Stork and Kogan.

Accordingly, the examiner's decision rejecting claims 1-10, 12-14, 16 and 17 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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LEE E. BARRETT)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
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)
ANITA PELLMAN GROSS)
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EK/RWK

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